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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,085	04/30/2007	Mario Polegato Moretti	293046US0PCT	6215

22850 7590 06/23/2010

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EXAMINER	
MOHANDESI, JILA M	
ART UNIT	**PAPER NUMBER**
3728	

NOTIFICATION DATE	DELIVERY MODE
06/23/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/585,085	MORETTI ET AL.	
	Examiner	Art Unit	
	JILA M. MOHANDESI	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *04 May 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-60* is/are pending in the application.

4a) Of the above claim(s) *55-59* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-54 and 60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *09/27/2006, 05/04/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election without traverse of Species I as shown in Figures 1-5 and 7 and claims 31-54 and 60 in the reply filed on 04/27/2010 is acknowledged.

2. Claims 55-59 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 31-54 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 31 recites the limitation "at least one of the two surfaces of said upper layer" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 31-54 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polegato (Pub. No. US 2002/0100187) in view of Rechlicz et al. (US 5,032,450). Polegato discloses a waterproof breathable sole for shoes (see Figures 1 and 3bis), comprising, for at least part of its extension, at least two structural layers, with a lower layer (13) provided with a supporting structure so as to form a tread, and an upper microporous layer (hydrophobic material 222b and hydrophilic material 222c, see Figure 3bis and paragraphs [0068] thru [0071]) that is permeable to water vapor, said lower layer having two, upper and lower surfaces and portions that are open onto said upper layer (See Figure 1), the upper layer having upper and lower surfaces and portions. Polegato is silent about at least one of the two surfaces of said upper microporous layer comprising a coating formed by plasma deposition treatment for forming a waterproof breathable material. Rechlicz et al. discloses that it is desirable to provide a moisture vapor permeable coating of hydrophobic polymer of polysiloxane on one side of a sheet of microporous matrix material of polylofin and siliceous filler, having interconnecting pores to make the membrane substantially impermeable to liquid water and permeable to moisture vapor. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a microporous matrix material coated with moisture vapor permeable coating of hydrophobic polymer of polysiloxane as the upper layer of the sole of Polegato as taught by Rechlicz et al. to make the upper layer

substantially impermeable to liquid water and permeable to moisture vapor. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

With respect to claims 32-34 and the upper surface, lower surface or both the lower and upper surface of the upper layer/membrane being provided with the coating, this would be an obvious design choice depending on the cost of manufacturing.

With respect to claims 42-54, the polysiloxane coating is applied on the microporous material by spreading (column 14, lines 10-20). Rechlicz does not specifically disclose the polysiloxane coating is obtained by way of a plasma deposition treatment. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Rechlicz is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The coated article comprises a moisture vapor permeable coating of polysiloxane on one side of the sheet of microporous material (abstract). The microporous material is a matrix of polyolefin and siliceous filler, having interconnecting pores. The microporous material has a thickness of 30 to 400 microns, an average pore size of 0.02 to 0.5 microns/micrometers and porosity in the range from 60 to 70% (column 3, lines 35-40; column 10, lines 20-22; and 30-35). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its

method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. In re Marosi, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Rechlicz et al.

With respect to claims 36-38 and 60, Rechlicz et al. discloses that the microporous material can be from a variety of materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the upper layer since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are waterproof breathable soles analogous to applicant's instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is

(571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
06/17/2010